
Status & Remarks

The application presently contains the following claims:

<u>Independent Claim #</u>	<u>Dependent Claim #s</u>
1	2-10
11	12-16
17	18-20

Claims 1, 6, 11, 12 and 17 are amended in this response.

Support for the amendment limitation "quality" in relation to the quantitative rating system may be found with reference to originally submitted Page 2, Lines 6-14 and Page 7, Lines 2-5.

Support for the amendment limitation "and wherein the staff person assists at least one member in obtaining the personalized medical care at the associated healthcare facility" and variations thereof among the differing claims may be found with reference to the originally submitted Page 2, Lines 23-25; Page 7, Line 21 through Page 8, Line 5; and within Example 1.

Support for the amendment limitation to the meeting between the at least one member and at least one officer of the healthcare facility wherein the meeting occurs "after said medical procedure is performed for facilitation of donations by said satisfied member" and variations thereof among the differing claims may be found with reference to the originally submitted Page 4, Lines 8-10; and Page 10, Line 29 through Page 11, Line 8.

Amending Claim 6 with the addition of the word "of" was made from grammatical reasons.

35 U.S.C. §103

The examiner has rejected Claims 1-20 under this section as being unpatentable over U.S. Patent Application Publication 2002/0194022 (hereinafter "Comite" or the "'022 Publication") in view of U.S. Patent Application Publication 2003/0182413 (hereinafter "Allen" or the "'413 Publication") and U.S. Patent Application Publication 2004/0093231 (hereinafter "Walz" or the

"231 Publication"). The examiner has provided thoughtful reasons to support the rejections. The applicant's attorney would respectfully request the examiner to revisit the initial conclusions in light of the following arguments as associated with the amended pending claims.

The examiner has represented that Comite teaches a method for specialized service at an associated healthcare facility, the facility having at least one healthcare provider, the method comprising the steps of offering preferred services to the member, performing at least one medical procedure on the member, and arranging at least one meeting between at least one satisfied member and at least one officer of the associated healthcare facility, all within the claimed invention.

It is respectfully submitted that Comite teaches of consultations between the patient and various practitioners for purposes including to obtain additional medical information from the patient [Page 5, Para 74], to strategize and develop a care plan with the patient [Page 11, Para. 172], and to provide ongoing medical care to the patient [Page 5, Para 075]. There is no mention within Comite of arranging at least one meeting between at least one satisfied member and at least one officer of the associated healthcare facility after a medical procedure has been performed in order to solicit donations from the patient, as is explained in the specification of the claimed invention [Page 4, Lines 8-10; and Page 10, Line 29 through Page-11, Line 8]. Claims 1 and 17 have been modified to clarify the timing and intention of the meeting between the patient and the officer of the associated healthcare facility. Comite further lacks teaching of using a quantitative rating system of quality to choose a healthcare facility, providing a dedicated staff person to assist at least one member in obtaining the medical care at the associated healthcare facility, tracking donations from a member, or soliciting donations from a member.

The examiner further represents that Allen teaches a system and method for allowing a service user to quantify and compare the desirability of competing service providers and selecting a service provider to perform particular service. The examiner also notes that a health care consumer would likely choose a facility with a high quality rating as that would be more suitable to the consumer's needs as Allen teaches. The applicant's attorney respectfully disagrees with this assumption by the examiner. The '413 Publication stresses the consumer's desired performance criteria may be any number of criteria, expressly naming not only quality criteria, but also cost criteria and timeliness criteria of the service provider [Page 2, Para 19-20]. Allen even teaches away from requiring the consumer to use solely quality rankings, going as far

as to allow the consumer to prioritize their desired performance criteria (including not only quality but also timeliness and cost), and allows the consumer to allocate a weight to each of the various criteria [Page 2, Para 40-45]. The consumer is able to choose any listed service provider that meets their needs considering quality, cost and timeliness, not just the service providers that are within approximately the top 20% of the quantitative rating system of quality of the facility.

Contrary to the above discussed teachings of Allen, the claimed invention focuses solely on quality criteria, as one purpose of the invention is to provide high net worth individuals with the best available health care while providing the best health care facilities to “develop a relationship with the individual and families who can help fund the needed research and development to improve health care for everyone.” [Page 2, Lines 6-14]. Any “quantitative measurements, ensuring top quality, can be used.” [Page 7, Lines 2-5]. The claimed invention focuses on superior traditional hospitals and medical facilities, such as world renowned hospitals that are able to provide exemplary specialists and state of the art medical technology. The only facilities offered by the membership provider to the member are those ranked in the top tiers by quantitative measurements of quality. Claims 1, 11, and 12 have been amended to limit the quantitative measurement system to that of quality.

The examiner further states that Walz teaches of elements of the invention as claimed, including the membership provider being a separate entity from the associated healthcare facility, providing at least one membership to at least one member, charging a membership fee, providing at least one dedicated staff person, wherein the staff person is at least partially supported by the membership provider, and conducting at least one satisfaction survey with the member. While Walz teaches of the organization providing services to the individual supported by the individuals [Page 1, Para 3], applicant’s attorney asserts there is no mention in Walz of a dedicated staff person to assist the member in receiving the personalized medical care from the associated healthcare facility. The invention as claimed makes clear the staff person is responsible for assisting the member in obtaining the personalized medical care from the associated healthcare facility [Page 2, Lines 23-25; Page 7, Line 21 through Page 8, Line 5; and within Example 1]. Claims 1, 11, and 17 have been amended to portray the role of the dedicated staff person.

Furthermore, it is important to note that Walz teaches of the blood and organ donations and payments of its members benefiting the membership provider [Page 1, Para 3]. There is no

mention within Walz of actively soliciting monetary donations from members. The claimed invention at hand teaches of the actively solicited donations of members benefiting the associated healthcare provider, which is a different entity from the membership provider [Page 2, Lines 6-14 and Lines 26-30].

It is respectfully submitted that the examiner may have hastily come to the conclusion that Walz teaches of conducting at least one satisfaction survey of a member, and that a second reading of the '231 Publication may lead the examiner to a different conclusion. The examiner interprets that the maintenance of member information and accounting of member vital statistics and contributions includes the satisfaction of the members. The examiner's assumption is incorrect, as this cannot be the case. The blood donations and organ donations do not require or facilitate satisfaction ratings, and no mention of any satisfaction rating is made within the '231 Publication. Furthermore, the member would not be able to rate their satisfaction of the funeral provided by the membership provider, as rating satisfaction is impossible after death.

As the examiner is familiar with, most inventions arise from a combination of old elements and each element may often be found in the prior art.¹ However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. The examiner must articulate the basis on which he concludes that it would have been obvious to make the claimed invention and explain the reasons one of ordinary skill in the art would have been motivated to select the references, or teachings contained therein and to combine them to render the invention obvious. This "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which §103 was meant to confront.² Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.³ Additionally, an obviousness determination requires not only the existence of a motivation to combine elements from different prior art references, but also that a skilled artisan

¹ *In re Leonard R. Kahn*, 441 F.3d 977, 987, (Fed. Cir. 2006), citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)

² *Kahn* at 986; *Rouffet* at 1357-59

³ *Kahn* at 988, citing *Cross Med. Prods.*, 424 F.3d 1293, 1321-24 (Fed. Cir. 2005)

would have perceived a reasonable expectation of success in making the invention via that combination.⁴ However, to have a reasonable expectation of success, one must be motivated to do more than merely to “vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.”⁵ Similarly, prior art fails to provide the requisite “reasonable expectation” of success where it teaches merely to pursue a “general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.”⁶

Applying the mandates of the Court of Appeal, Federal Circuit, it is clear that *Comite* merely provides a starting point for the experimentation, and that only by trial and error, would perhaps, a serendipitous result be arrived at by the experimentalist as taught by the *Rowley* invention, and as claimed by the pending application. There is absolutely no teaching within *Comite* to combine any meeting between an officer of the healthcare facility and a satisfied member in order to solicit donations from the member, using a quantitative rating system of quality to choose a healthcare facility, providing a dedicated staff person as claimed in the *Rowley* invention to assist at least one member in obtaining the medical care at the associated healthcare facility, tracking donations from a member, or soliciting donations from a member and to imply there is would be to employ impermissible hindsight. Furthermore, there is no teaching in any of the cited references that teaches of choosing the associated healthcare facility from the top tiers of quality using a quantitative rating system of quality alone, let alone teaching of a meeting between a satisfied member and an officer of the associated healthcare facility in order to solicit donations.

It is hard to fathom what suggestion an experimentalist would be following to arrive at the claimed subject matter as stated by the examiner. There is none stated within *Comite*, thereby leading to the very result cautioned against by the Court of Appeals, Federal Circuit, in *Medichem*, namely to “vary all parameters or try each of numerous possible choices until one

⁴ *Medichem, S.A. v. Rolabo, S.L.* 437 F.3d 1157, 1165 (Fed. Cir. 2006), citing *In re O’Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988)

⁵ *Medichem* at 1165; *O’Farrell* at 903

⁶ *Medichem* at 1165; *O’Farrell* at 903

possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful." At best, Comite teaches merely to pursue a "general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it."

Request for Reconsideration


Applicant believes that all independent claims clearly define over the prior art and that the distinctions between the present invention and the prior art would not have been obvious to one of ordinary skill in the art. Additionally, the remaining dependent claims, by the limitations contained in the base independent claims, are felt to be patentable over the prior art by virtue of their dependency from independent claims which distinguish over the prior art of record. All pending claims are thought to be allowable and reconsideration by the examiner is respectfully requested.

A fee determination sheet is attached for this amendment response. The Commissioner is hereby authorized to charge any additional fee required to effect the filing of this document to Account No. 50-0983.

If the examiner believes that a telephonic conversation would facilitate a resolution of any and/or all of the outstanding issues pending in this application, then such a call is cordially invited at the convenience of the examiner.

Buckingham, Doolittle & Burroughs, LLP
50 S. Main St.
P.O. Box 1500
Akron, Ohio 44309-1500
(330) 258-6453 (telephone)
(330) 252-5452 (fax)
Attorney Docket #: 39288.0222

Respectfully Submitted,
Buckingham, Doolittle & Burroughs, LLP



Louis F. Wagner
LWagner@bdblaw.com
Registration No.: 35,730

«AK3:841553_v1»